

REMARKS

Claims 47-107 were previously submitted for examination. Claims 47-68 and 98-107 were withdrawn from consideration. Claims 1-46 were canceled by the Preliminary Amendment submitted on January 16, 2004 and claims 72-77, 85, 87-91 and 94 were canceled by the March 23, 2007 Amendment. Claims 70, 82, 108-112, 114-119, 121-126 and 128-131 were cancelled, 69, 78, 79, 86 and 92 were amended, and claims 132-147 were added by the Preliminary Amendment submitted on November 5, 2009. Claims 132-134, 136-138, 140-142 and 144-146 have been amended, claims 97, 135, 139, 143 and 147 have been cancelled and new claims 148-151 have been added by the present Amendment. Therefore claims 69, 71, 78-81, 83, 84, 86, 92, 93, 95, 96, 113, 120, 127, 132-134, 136-138, 140-142, 144-146 and 148-151 are under active consideration.

Support for the amended claims 132, 136 and 140 for reciting an “PTH₁₋₆ is part of the reactive portion of the isolated antibody” can be found throughout the present application, *e.g.*, at page 12, line 8 through page 13, line 4 of the present application.

Support for the amended claims 133, 137 and 141 for reciting an “PTH₁₋₇ is part of the reactive portion of the isolated antibody” can be found throughout the present application, *e.g.*, the teaching of an antibody specific for the initial wPTH peptide sequence which comprises a domain for adenylate cyclase activation (the present application at page 9, lines 14-21) and teaching that a domain for adenylate cyclase activation comprises PTH amino acid residues 1 to 7 (the present application at page 2, lines 9-10).

Support for the amended claims 134, 138 and 142 for reciting an “PTH₁₋₈ is part of the reactive portion of the isolated antibody” can be found throughout the present application, *e.g.*, at page 5, line 25 through page 6, line 1 of the present application.

Support for the new claims 148-151 for reciting an “said isolated antibody does not specifically bind to a PTH₇₋₈₄ fragment” can be found throughout the present application, *e.g.*, in Figures 5 and 11 of the present application.

Accordingly, the present amendments do not introduce any new matter. Entry of the amendments is respectfully requested.

With respect to all amendments and canceled claims, applicants have not dedicated or abandoned any unclaimed subject matter and moreover have not acquiesced to any rejections and/or objections made by the Patent Office. Applicants reserve the right to pursue prosecution of any presently excluded claim embodiments in future continuation and/or divisional applications.

Priority

The Examiner asserted that the priority of the present application is filing date, *i.e.*, 1/16/2004. (The January 15, 2010 Office Action at pages 2-4.)

Applicants respectfully disagree with the Examiner's assertion. However, no prior art based rejection remains in the present case and the alleged priority issue is moot.

Claim Rejections - 35 USC § 112

Claims 132-147 were rejected under 35 U.S.C. 112, first paragraph, as allegedly failing to comply with the written description requirement. (The January 15, 2010 Office Action at pages 4-5.)

Applicants respectfully traverse this rejection. However, in order to advance prosecution of the present application, claims 132-147 have been amended and/or canceled, which amendments and cancelation render this rejection moot. In addition, the amended claims 132-134, 136-138, 140-142, 144-146 and new 148-151 have adequate support in the present application as discussed above.

Therefore, applicants respectfully submit that the present application and parent patents provide an adequate written description for the presently pending claims and the written description rejection can properly be withdrawn.

Double Patenting

Claims 69, 71, 78-81, 83-84, 86, 92-93, 95-97 and 113, 120, 127, 132-147 were provisionally rejected on the ground of nonstatutory double patenting over claims 1-9, 59, 98-105, 113-114, 139-143 of copending Application No. 10/617,489. (The January 15, 2010 Office Action at pages 5-6.)

Applicants respectfully traverse this rejection. However, in order to advance prosecution of the present application, a Terminal Disclaimer regarding a patent issued from copending Application No. 10/617,489 is submitted herewith, which submission renders this rejection moot.

Claims 69, 71, 78-81, 83-84, 86, 92-93, 95-97 and 113, 120, 127, 132-147 are rejected on the ground of nonstatutory double patenting over claims 1-4 of U. S. Patent No. 6,689,566 since the claims, if allowed, would allegedly, improperly extend the "right to exclude" already granted in the patent.

Applicants respectfully traverse this rejection. However, in order to advance prosecution of the present application, a Terminal Disclaimer regarding U. S. Patent No. 6,689,566 is submitted herewith, which submission renders this rejection moot.

Therefore, applicants respectfully submit that the nonstatutory double patenting rejections are rendered moot by the Terminal Disclaimers and the rejections can properly be withdrawn.

CONCLUSION

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

In the event the U.S. Patent and Trademark office determines that an extension and/or other relief is required, applicants petition for any required relief including extensions of time and authorize the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing docket No. 532212000624. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

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Respectfully submitted,

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